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| EXAMINER |
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CROW, ROBERT THOMAS

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| ART UNIT | PAPER NUMBER |
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1634

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

08/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | | |
|---|--------------------------------------|-----------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/526,402 | Applicant(s) KIM ET AL. | |
| | Examiner Robert T. Crow | Art Unit 1634 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: None.
- Claim(s) objected to: 2.
- Claim(s) rejected: 1,2,5-8 and 26-29.
- Claim(s) withdrawn from consideration: 3,4 and 9-25.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Diana B. Johannsen/
Primary Examiner, Art Unit 1634

Continuation of 3. NOTE: The amendments filed 11 August 2008 further limit the spots on the biochip of claim to be circular and also further prohibit the biomaterials to be covalently bound to the gel. These new limitations further narrow the scope of the claims and therefore require further search and consideration because the claims now requires these additional limitations. These new limitations were not present in the claims at the time of the final rejection and therefore will not be searched.

In addition, the amendments filed 11 August 2008 require claim 4, which was previously withdrawn as a result of being drawn to a non-elected invention, to be dependent on claim 1, which is under prosecution. Furthermore, as noted above, the amendments filed 11 August 2008 include new claims 30-31. Thus, while the amendments have cancelled previously withdrawn (i.e., unexamined) claim 3 and previously examined claim 28, the amendments have added a total of three new claims not previously examined at the time of the final rejection, which would require further search and consideration. The limitations of previously withdrawn claim 4 and new claims 30-31 were not present in the examined claims at the time of the final rejection and therefore will not be searched..

Continuation of 11. does NOT place the application in condition for allowance because:

A. Applicant's arguments on pages 9-10 of the Remarks filed 11 August 2008 (i.e., the "Remarks") refer to the amended claims and rely solely on the amendments. Since the amendments were not entered, the arguments drawn to the after final amendments have not been considered.

B. Applicant argues on pages 14-16 of the Remarks that because Kim et al allegedly do not teach gel spots integrated in a chip in amounts of up to 1000 spots/cm², claims 1 and 30 are allowable.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., spots integrated in a chip in amounts of up to 1000 spots/cm²) are not recited in rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). While claim 30 does recite the limitation, claim 30 is a new claim present in the examined claims at the time of the final rejection. Thus, the arguments regarding claim 30 are moot because claim 30 has not been entered.

C. Applicant further argues on page 15 of the Remarks that in contrast to Kim et al, the present invention is further interested in the morphology of the spots formed on the chip. Applicant thus appears to be arguing that Kim et al does not teach the shape of the spots. Applicant's arguments therefore refer to the amended claims and rely solely on the amendments. Since the amendments were not entered, the arguments drawn to the after final amendments have not been considered.

D. Applicant further argues on pages 15-16 of the Remarks that the present invention requires a sol mixture that promotes gelation which is not separated during the assay, and that the coating is hydrophobic. Thus, Applicant appears to be arguing unexpected results.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a sol mixture and a hydrophobic coating) are not recited in rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, the courts have stated: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP§ 2113.

Applicant's arguments refer to limitations that are part of the process of making the biochip rather than structural limitations of the biochip. Because Kim et al teach the structural elements of previously claimed biochip, the previously claimed biochip is anticipated by Kim et al. In addition, in response to Applicant's apparent arguing of expected results, MPEP 716.01(c) makes clear that "The arguments of counsel cannot take the place of evidence in the record" (*In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965)). Finally, the Response above should not be construed as an invitation to file an after final declaration. See MPEP 715.09 [R-3].

E. Applicant argues on pages 16-19 of the Remarks that Anderson et al fails to teach the morphology of the spots, of a substrate selected from PMMA, PC, and COC, a PVAc coating agent, and biomaterials not immobilized with covalent bonds. Applicant's arguments therefore refer to the amended claims and rely solely on the amendments. Since the amendments were not entered, the arguments drawn to the after final amendments have not been considered.

F. Applicant argues on pages 16-19 of the Remarks that both references of Dordick et al fail to teach the morphology of the spots, of a substrate selected from PMMA, PC, and COC, a PVAc coating agent, and biomaterials not immobilized with covalent bonds. Applicant's arguments therefore refer to the amended claims and rely solely on the amendments. Since the amendments were not entered, the arguments drawn to the after final amendments have not been considered.

G. Applicant's arguments on pages 19-20 of the Remarks rely on arguments set forth to address the rejections of the claims as anticipated by Kim et al, Anderson et al, and Dordick et al under 35 USC 102(a,b,e). These arguments are addressed above. Since the arguments regarding the teachings of Kim et al, Anderson et al, and Dordick et al were not persuasive, the remaining rejections of the claims are maintained.

Examiner, Art Unit 1634.